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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,413	01/22/2004	Ian Peek	2810	4528
7590 04/12/2005 STRIKER, STRIKER & STENBY 103 East Neck Road Huntington, NY 11743			EXAMINER LEGESSE, NINI F	
			ART UNIT 3711	PAPER NUMBER
DATE MAILED: 04/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,413

Applicant(s)

PEEK, IAN

Examiner

Nini F. Legesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-11 is/are rejected.
7) ☒ Claim(s) 9 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Request for Continued Examination is acknowledged on 03/28/05.

Since the Advisory Action of 12/14/04 already stated that the proposed claims were not to be entered because they fail to place the application in better form for appeal and also since the action also briefly states that the proposed amended claims still read on the prior art, this office action is made final. Please note that the Examiner did not state that the proposed amendments raised new issues in the Advisory sent. The currently amended claims are not different than the proposed claims of 12/07/04.

Affidavit

Affidavit is not considered. It is missing a signature and a date.

Claim Objections

Claim 9 is objected to because of the following informalities: this claim is depending on a cancelled claim. Appropriate correction is required. **For purpose of examination, claim 9 is assumed to be dependent on claim 1.**

Claim Rejections - 35 USC § 112

11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said inflatable rod" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hesselbart (US Patent No. 5,013,044).

- **With respect to claim 1**, Hesselbart discloses an upright rack (76); a rod (78) provided on said rack (76) and aligned substantially horizontally and parallel to a desired hitting direction, said rod being arranged at a distance to said rack such that a golf club is swingable through underneath said rod (Please refer to Fig. 2 of the reference wherein rod 78 is shown off center at a distance from the rack element 76); and further comprising an extension (88) which is connected with said rod and said rack and extends between said rod and said rack so as to hold said rod at the distance to said rack.
- **With respect to claim 3**, the rod is disposed substantially at a height of a forearm of a golfer (see Fig. 1).
- **With respect to claim 10**, the rod (78) and said rack (76) are dismountable from one another (as shown on Fig. 2, the wing set screws 94, 96, and 102 provide the capability of dismounting the rod and the rack elements).

Claims 1, 3, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tarulli et al. (US Patent No. 6,343,998).

- **With respect to claim 1**, Tarulli discloses an upright rack (41); a rod provided on said rack and aligned substantially horizontally (57,61) and parallel to a desired hitting direction (see Fig. 2), the rod being arranged at a distance to said rack such that a golf club is swingable through underneath said rod (the structure as shown on Fig. 1 is capable of being used for the function specified in this claim); and further comprising an extension (51 and some of the telescoping unites 57 that are directly attached to element 51 as shown in Fig. 1) which is connected with said rod and said rack and extends between said rod and said rack so as to hold said rod at the distance to said rack. With respect to the intended use of the claim, that the device is to be used as a golf training apparatus for practicing straight hits, it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the Tarulli's device is obviously capable of being used as a training apparatus (see MPEP 2111 and 2112).
- **With respect to claim 3**, the rod is disposed substantially at a height of a forearm of a golfer (since the device is adjustable, the rod element 61 is capable of being positioned at a height of a forearm of a golfer).
- **With respect to claim 8**, the rack is adjustable in height (column 3, lines 20-24).

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- **With respect to claim 9**, the extension is arranged extendably on said rack (see Fig. 1).

Claims 1, 4, and 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by McKinney (US Patent No. Des. 324,554).

- **With respect to claim 1**, McKinney discloses an upright rack (the vertical element as shown on Fig. 1); a rod provided on said rack and aligned substantially horizontally (the horizontal element as shown on Fig. 1) and parallel to a desired hitting direction (see Figs. 1-6), the rod being arranged at a distance to said rack such that a golf club is swingable through underneath said rod (the structure as shown on Figs. 1-6 is capable of being used for the function specified in this claim), and further comprising an extension (the elbow element as shown on Fig. 5) which is connected with said rod and said rack and extends between said rod and said rack so as to hold said rod at the distance to said rack. With respect to the intended use of the claim, that the device is to be used as a golf training apparatus for practicing straight hits, it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the McKinney's device is obviously capable of being used as a training apparatus (see MPEP 2111 and 2112).

- **With respect to claims 4 and 5**, the horizontal rod element between the verticals as shown on Fig. 1 is what is considered rod. The rod and the extension (the elbow element shown on Figs. 5-6 is what is considered as an extension) are inflatable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney in view of Shute (US Patent No. 2,592,347).

McKinney discloses the invention as recited above but fails to show an air pump wherein said air pump is manually operatable. However Shute teaches that the use of a manual pump (7) to inflate elements (see item 5 in Figs. 1-4) is not new. Thus, it would have been obvious to one of ordinary skill in the art to provide a pump in the McKinney device as taught by Shute in order to be able to readily and easily inflate the device for usage.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson (US Patent No. 3,768,501).

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Elson discloses an upright rack made of a rigid material (33) and an inflatable element (10) is provided on said upright rack aligned substantially horizontally and parallel to a desired hitting direction (see Fig. 1). However, the inflatable balloon element 10 fails to be in a rod shape. It is known that balloons come in different shapes including cylindrical shaped balloons that could be considered as a rod. With respect to the intended use of the claim, that the device is to be used as a golf training apparatus, it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the Elson's device is obviously capable of being used as a training apparatus (see MPEP 2111 and 2112).

Response to Arguments

Applicant's arguments filed 03/28/05 have been fully considered but they are not persuasive.

On pages 6-7 of Applicant's remarks, Applicant argues that the mounting block 88 of Hesselbart could not be considered as an extension. However, Fig. 2 of the reference clearly shows that rod (78) is located at some distance from the rack element (22).

On page 8 of Applicant's remarks, Applicant argues that the rod 57 or 61 of the Tarulli's reference is not arranged parallel to the hitting direction but it is perpendicular to the hitting direction. Applicant also argues that the rod formed by members 51, 57, and 61

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would not be disposed at a distance from the upright rack. This argument is not persuasive because the device of Tarulli is adjustable in a lot of ways. For example the telescoping rod elements has ends 59 wherein a ball and socket joint that has sufficient friction to ensure that the arms can be held at right angles (see column 3, lines 53-56). In addition column 3, lines 57-61 state that the swing arms 61 could be aligned with the extension 51 such that the swing arms and the extension lie in a straight line so that the telescoping segments 57 could be pushed together for storage purpose. Therefore, the arms could extend ever way one wishes and one could also position his/her body at different positions to utilize this device for different reasons. And it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the Tarulli's device is obviously capable of being used as the claimed training apparatus (see MPEP 2111 and 2112).

On pages 9-11 of Applicant's remarks, Applicant argues that the Examiner did not correctly interpret that invention disclosed by the Elson reference. Applicant also argues that the Elson's reference is a non-analogous art. Examiner clearly understands that the main invention in Elson is the valve. However, the reference teaches the use of a tank 33 along with the valve and the use of a balloon (10) along with the tank and the valve. With regards to the non-analogous argument, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned,

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in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is pertinent because the claimed structure is broad and could read in a lot of things not related to golf. Even though the device is non-analogous, it is capable of use as claimed (see MPEP 2111 and 2112).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. It is noted that in the advisory action mailed 14 December 2004, the examiner did not indicate that the amendments provided new issues and explained to applicant how the proposed amended claims would still be rejected over the prior art of record. The same grounds of rejection in the final rejection 30 November 2004 have been applied in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL

04/05/05


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